

## REMARKS

Claims 1, 10, 18, 26, 33, 36, 38, 42 and 48 have been amended. Claims 1-51 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### Objection to the Drawings:

FIG. 1 has been amended to overcome the objection. No new matter has been added since the amended drawing merely reflects what was described in the original specification and claims.

### Objection to the Specification:

The specification has been amended to overcome the Examiner's objection.

### Section 103(a) Rejection:

The Examiner rejected claims 1-6, 8-21, 23-32 and 42-51 under 35 U.S.C. § 103(a) as being unpatentable over De Greef et al. (U.S. Patent 6,549,217) (hereinafter "De Greef") in view of Smethers (U.S. Publication 2003/0055870) (hereinafter "Smethers"). Applicant respectfully traverses this rejection for at least the following reasons.

**In regard to claim 1, contrary to the Examiner's contention, De Greef in view of Smethers does not teach or suggest a client computer system operable to execute program instructions stored in its memory to receive user authentication information from a user, and communicate with a server computer system to authenticate the user for storing bookmark information to the server, using the user authentication information.** The Examiner refers to col. 11, lines 35-46 of De Greef. However, De Greef only teaches the client system 70 "validates a user's identity at logon

and establishes user access permissions to [client] system 70." Thus, De Greef only teaches a general logon user validation for the client system itself. The logon described in De Greef does not authenticate a user of the client system to store bookmark information to a server. Nor is De Greef's logon process performed by communicating with a server. Moreover, Smethers is completely silent as to any authentication of the user for storing bookmark information to the server. Thus, neither De Greef nor Smethers, alone or in combination, teaches or suggests a client computer system operable to execute program instructions stored in its memory to receive user authentication information from a user, and communicate with a server computer system to authenticate the user for storing bookmark information to the server, using the user authentication information.

Furthermore, Smethers does not suggest modifying the bookmark information in De Greef to specify a URL. De Greef specifically teaches that his bookmarks specify a display arrangement which has nothing to do with specifying a URL. The Examiner states that it would have been obvious to modify De Greef's system according to Smethers "for the purpose of enabling a wireless client to device to implement bookmarks with improved transmission efficiency, less navigation actions and/or reduced amounts of memory resources, thereby, selecting bookmarks with greater speed and ease." However, the way that Smethers accomplishes its goal of improved transmission efficiency and reduced memory resources is by avoiding the transmissions and storage of URLs in bookmarks for wireless client devices. See, e.g., Smethers, paras. 0014, 0016, 0036 and 0050. Thus, the reasons given by the Examiner to modify De Greef's systems according to Smethers are actually reasons to not specify URLs in the bookmarks. Smether's actually teaches away from the modification proposed by the Examiner. References that teach away cannot serve to create a *prima facie* case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994).

Similar arguments apply in regard to independent claims 10, 18, 26, 42 and 48. Therefore, Applicant asserts that the rejection of claims 1-6, 8-21, 23-32 and 42-51 is unsupported by the cited art and withdrawal thereof is respectfully requested.

The Examiner rejects claims 7, 22 and 49 under 35 U.S.C. § 103(a) as being unpatentable over De Greef in view of Smethers and further in view of Mendelevitch et al. (EP 1030247 A2) (hereinafter "Mendelevitch").

**In regard to claim 7, contrary to the Examiner's contention, De Greef in view of Smethers and further in view of Mendelevitch does not teach or suggest a client computer system operable to determine whether the user wants to store the bookmark information locally or remotely in response to receiving user input requesting to store bookmark information.** The Examiner acknowledges that neither De Greef nor Smethers teaches this feature. The Examiner relies upon Mendelevitch paras. 0005, 0026 – 0028 and 0031-0035. However, Applicant asserts that the Examiner's reliance on Mendelevitch is misplaced. Although Mendelevitch does mention that bookmarks may be stored both locally on client 12 and duplicated to database 20, Mendelevitch does not teach or suggest a client system determining whether the user wants to store the particular bookmark information indicated by the user input locally or remotely in response to receiving the user input requesting to store the bookmark information. In other words, Mendelevitch's client system does not make such a determination for the particular bookmark information indicated by a user input request. Instead, Mendelevitch only teaches duplicating all of the client bookmark information to the database 20. Thus, none of De Greef, Smethers or Mendelevitch, alone or in combination, teaches or suggests a client computer system operable to determine whether the user wants to store the bookmark information locally or remotely in response to receiving user input requesting to store bookmark information. Similar arguments apply in regard to claims 22 and 49.

The Examiner rejects claims 33-41 under 35 U.S.C. § 103(a) as being unpatentable over Smethers in view of Mendelevitch. Applicant respectfully traverses this rejection for at least the following reasons.

In regard to claim 33, contrary to the Examiner's contention, Smethers in view of Mendelevitch does not teach or suggest a first computer system receiving user input specifying bookmark information, wherein the bookmark information specifies a uniform resource locator (URL); the first computer system communicating with a server computer system in order to store the bookmark information on the server computer system; and a second computer system communicating with the server computer system in order to retrieve the stored bookmark information including the URL. The Examiner acknowledges that Smethers does not teach a second computer system communicating with the server computer system in order to retrieve the stored bookmark information. The Examiner relies on Mendelevitch to teach this feature. However, the Examiner's combination of Smethers and Mendelevitch is improper because Smethers explicitly teaches away from a second client computer retrieving the same bookmark information including the URL from the server that was stored by the first client computer. The main purpose of Smethers teachings is to provide bookmarking for remote wireless client devices that avoids the client device having to receive and store complete bookmarks including URLs. See, e.g., Smethers, paras. 0014, 0016, 0036 and 0050. Thus, to modify the client device of Smethers to retrieve the same bookmark information including the URL from the server that was stored by the first client computer would be counter to the intended purpose of Smethers' teachings. If a proposed modification would render the prior art feature unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983).

Similar arguments apply in regard to independent claims 36 and 38. Therefore, Applicant asserts that the rejection of claims 33-41 is unsupported by the cited art and withdrawal thereof is respectfully requested.

## **CONCLUSION**

Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-78600/RCK.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Drawing Replacement Sheet for FIG. 1
- Notice of Change of Address
- Fee Authorization Form authorizing a deposit account debit in the amount of \$ for fees ( ).
- Other:

Respectfully submitted,



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